

PATENT
Attorney Docket No. 98-027
Express Mail No. EV192166718US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
Verne C. Hornbeck and)	
Derryl D.J. Allman)	
)	Group Art Unit: 2877
Serial No. 09/217,183)	
)	Confirmation No.: 8652
Filed: December 21, 1998)	
)	Examiner: L. G. Lauchman
For: ON-CHIP GRADED INDEX OF)	
REFRACTION OPTICAL WAVEGUIDE)	
AND DAMASCENE METHOD OF)	
FABRICATING THE SAME)	

CERTIFICATE OF MAILING BY EXPRESS MAIL

BOX: AF
Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

The undersigned hereby certifies that the attached Notice of Appeal and Request to Settle Matters Not Affecting the Merits of the Invention; Certificate of Mailing by Express Mail; and Return Card, relating to the above application, were deposited as "Express Mail," Mailing Label No. EV192166718US with the United States Postal Service, addressed to The Commissioner of Patents and Trademarks, Washington, D.C. 20231, on this 3rd day of January, 2003.

1/3/03
Date

1/3/03
Date

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NOTICE OF APPEAL

and

Request to Settle Matters Not Affecting the Merits of the Invention

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Notice is hereby given of the appeal of the final rejection of claims 1-4, 11, 12, and 27-29, and the "objection" to the specification as set forth in the final office action mailed October 3, 2002. Claims 5-10 have been noted as allowed in the October 3, 2002 office action, and this notice of appeal does not apply to the determination of patentable subject matter with respect to claims 5-10. However, it is presumed that the "objection" applies to claims 5-10. This notice is given under the provisions of 37 CFR 1.191.

A request is hereby made under the provisions of 37 CFR 1.191(c) for a clear statement identifying (a) the legal basis for the "objection" and (b) the "common knowledge in the art" which is relied on for the obviousness rejection.

No legal basis is stated in the October 3, 2002 office action for the "objection." Without a clear statement of the legal basis for the "objection," the applicant cannot adequately respond. The applicant should not be forced to

guess that the legal basis for the Examiner's position, only to find that the guess was not consistent with the Examiner's unstated intentions.

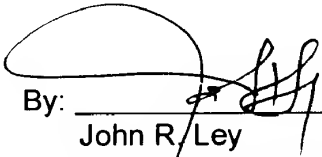
The obviousness rejection of claims 1-4, 11, 12, and 27-29 is based on U.S. patent 5,281,305 "in view of common knowledge in the art." The alleged "common knowledge in the art" is not identified in the October 3, 2002 office action. In a July 10, 2002 response to a previous office action, the Examiner's attention was called to the fact that the "common knowledge in the art" had not been identified. In the October 3, 2002 office action, the Examiner responded to this point by apparently indicating five references (U.S. patents 5,235,663, 5,562,838, 5,604,835, 4,744,623 and 4,146,298) as representing this "common knowledge in the art." If these five references do indeed represent the "common knowledge in the art," it would appear that the rejection should have been based on the '305 patent in combination with one or more of these five references. However, that is not the basis for the final rejection. The applicant should not be forced to guess at the basis for the final rejection.

The two requested clarifications are necessary to prepare an appeal brief which complies with the requirements of 37 CFR 1.192(c).

Charge the fee for this Notice of Appeal to deposit account 12-2252.

Respectfully submitted,

Date: 1/3/03

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